

**Amendment and Response**

Applicant: Patrick Brouhon

Serial No.: 10/670,782

Filed: September 26, 2003

Docket No.: 500201773-2

Title: SYSTEM FOR AND METHOD OF PRINTING FROM A DIGITAL CAMERA IMAGE PROOF SHEET

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**REMARKS**

The following remarks are made in response to the Office Action mailed February 4, 2008. Claims 1-17 were rejected. With this Response, claims 1-5, 10, and 17 have been amended. Claims 1-17 remain pending in the application and are presented for reconsideration and allowance.

**Examiner Suggestion**

The Examiner suggested amending the “capable of” language of independent claim 1 to recite a positive limitation in replace thereof. Amended independent claim 1 recites the positive limitation of “a printer configured to generate.”

**Claim Rejections under 35 U.S.C. § 112**

The Examiner rejected claims 1-16 under 35 U.S.C. § 112, second paragraph, as failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention.

Amended independent claim 1 recites recording to the spatial location of user-applied indicia on the proof-sheet via a pen that applies the user-applied indicia to at least one of the user designation areas on the proof-sheet, and transmitting the spatial location of the user-applied indicia to the printer. In addition, Applicant has amended corresponding dependent claims depending from claim 1 to also refer to the spatial location of the user-applied indicia. As such, amended independent claim 1 and its dependent claims now properly define the spatial location of user-applied indicia.

In view of the above, claims 1-16 are believed to be in form for allowance. Therefore, Applicant respectfully requests that rejections to these claims under 35 U.S.C. § 112, second paragraph, be reconsidered, and that the rejections be removed and claims 1-16 be allowed.

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**Claim Rejections under 35 U.S.C. § 103**

The Examiner rejected claims 1-7, 10-12, 14, and 16-17 under 35 U.S.C. § 103(a) as being unpatentable over the Testa et al. U.S. Patent No. 6,745,186 in view of the Hicks U.S. Patent No. 5,359,387.

The Examiner rejected claims 8-9 and 15 under 35 U.S.C. § 103(a) as being unpatentable over the Testa et al. U.S. Patent No. 6,745,186 and the Hicks U.S. Patent No. 5,359,387 in view of the Jared et al. U.S. Patent No. 6,208,771.

The Examiner rejected claim 13 under 35 U.S.C. § 103(a) as being unpatentable over the Testa et al. U.S. Patent No. 6,745,186 and the Hicks U.S. Patent No. 5,359,387 in view of the Chai U.S. Patent No. 6,393,138.

Amended independent claim 1 recites **recording the spatial location of the user-applied indicia on the proof-sheet via a pen that applies the user-applied indicia** to at least one of the user designation areas on the proof-sheet, and transmitting the spatial location of the user-applied indicia to the printer.

Amended independent claim 17 recites the paper and pen are arranged so that user-applied indicia corresponding to the image manipulation commands **applied by the user with the pen to the proof-sheet are adapted to be transmitted to the printer by recording, via the pen, the spatial position of the user-applied indicia** and the recorded spatial position of the user-applied indicia are adapted to be transmitted to the printer.

These recited limitations of amended independent claim 1 and amended independent claim 17 are not taught or suggested, alone or in combination, by the Testa et al. Patent and the Hicks Patent.

The Testa et al. Patent discloses a computer software product and a method of organizing and searching images. The digital images may be obtained from a plurality of hard copy prints that are digitally scanned. The digital images are analyzed in accordance with a predetermined criteria based on information obtained by scanning of images. The Testa et al. Patent specially discloses at column 8, lines 5-25 that the image instruction form 74 of Figure 6A includes writing areas 86, 88, and 89 for providing information that can be read by either a human or a machine, such that when the image instruction form 74 is scanned

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prior to the group of hardcopy prints, commonly available software can be employed to convert the hand-written letters of writing areas 86, 88, and 89 into ASCII characters.

Consequently, the Testa et al. Patent does not teach or suggest the limitations of amended independent claim 1 of recording the spatial location of user-applied indicia on the proof-sheet via a pen that also applies the user-applied indicia or the limitation of amended independent claim 17 of the paper and pen being arranged so that user-applied indicia corresponding to image manipulation command applied by the user with the pen to the proof-sheet are adapted to be transmitted to the printer by recording, via the pen, the spatial position of the user-applied indicia and the recorded spatial position of the user-applied indicia are adapted to be transmitted to the printer. Moreover, by teaching that the hardcopy prints are digitally scanned and the digital image is analyzed in accordance with the predetermined criteria based on the information obtained by scanning the images, the Testa et al. Patent teaches away from the above limitations of amended independent claims 1 and 17 related to recording the spatial location of the user-applied indicia on the proof-sheet via the pen that also applies the user-applied indicia and also transmitting this recorded spatial location of the user-applied indicia to the printer.

The Hicks Patent also does not teach these above-recited limitations of amended independent claims 1 and 17. The Hicks Patent discloses a photographic process for institutional groups in which several exposures are taken of each subject in the group. The Hicks Patent at column 3, lines 21-36 specially discloses that the negatives are printed in proof form on a single sheet of proof paper or “contact sheet” using stored composition data from the computer database, and an order form is printed on the same sheet of proof paper simultaneously with the printing of the proof prints. Each order form comprises a series of blocks numbered, for example, 1-7 with printed directions above each series of blocks to “select package.” As such, the Hicks Patent in no way teaches or suggests the limitations of amended independent claims 1 and 17 related to recording the spatial location of a user-applied indicia on the proof-sheet via the same pen that applies the user-applied indicia and further transmitting this recorded spatial location of the user-applied indicia to the printer.

Furthermore, dependent claims 2-16 further define patentably distinct amended independent claim 1. Therefore, these dependent claims are also believed to be allowable.

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Therefore, Applicant respectfully requests reconsideration and withdrawal of the 35 U.S.C. § 103(a) rejection to the claims, and request allowance of claims 1-17.

**CONCLUSION**

In view of the above, Applicant respectfully submits that pending claims 1-17 are in form for allowance and are not taught or suggested by the cited references. Therefore, reconsideration and withdrawal of the rejections and allowance of claims 1-17 is respectfully requested.

No fees are required under 37 C.F.R. 1.16(h)(i). However, if such fees are required, the Patent Office is hereby authorized to charge Deposit Account No. 08-2025.

The Examiner is invited to contact the Applicant's representative at the below-listed telephone numbers to facilitate prosecution of this application.

Any inquiry regarding this Amendment and Response should be directed to either Patrick G. Billig at Telephone No. (612) 573-2003, Facsimile No. (612) 573-2005 or Michael Kraft at Telephone No. (970) 898-0883, Facsimile No. (970) 898-7247. In addition, all correspondence should continue to be directed to the following address:

IP Administration  
Legal Department, M/S 35  
HEWLETT-PACKARD COMPANY  
P.O. Box 272400  
Fort Collins, Colorado 80527-2400

Respectfully submitted,

Patrick Brouhon,

By his attorneys,

DICKE, BILLIG & CZAJA, PLLC  
Fifth Street Towers, Suite 2250  
100 South Fifth Street  
Minneapolis, MN 55402  
Telephone: (612) 573-2003  
Facsimile: (612) 573-2005

Date: May 5, 2008

PGB:cmj:mlm

/Patrick G. Billig/

Patrick G. Billig

Reg. No. 38,080